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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: \ 09/755,330

Filing Date: 1/5/01

Applicant: Weaver et al.

Group Art Unit: 2837

Examiner: Marlon T. Fletcher

Title: BRUSHLESS DC MOTOR

Attorney Docket: 0275D-000289

TECHNOLOGY UNIT 2837
NOV - 6 2002
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Commissioner of Patents and Trademarks
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed October 1, 2002, applicants respond as follows:

Applicants elect with traverse the claims of Group 1, claims 1 – 13 and 40 – 49.

Applicants respectfully submit that the restriction requirement is improper for the following reasons.

As to the claims of Groups 1 and II, the Examiner takes the position that they are related as a combination and subcombination and are distinct because the combination as claimed does not require the particulars of the subcombination as claimed for patentability. That is, "the combination as claimed does not require the particulars of

the subcombination as claimed because Power tool is [sic] combination containing the subcombination of the dc brushless motor. The subcombination has separate utility such as a motor for providing power."

MPEP § 806.05(c) sets forth the criteria for determining when combination and subcombinations are distinct. Two-way distinctiveness is required. That is, the inventions are distinct if a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

Comparing claim 1, the first subcombination claim, to claim 14, the first combination claim, applicants submit that the Examiner has failed to show that criteria (A) is met. The power tool combination recited in claim 14 includes the limitations recited in claim 1. Restriction is thus improper. Moreover, since claim 14 includes the limitations of claim 1, the search for claim 14 would involve the same classes/subclasses as the search for claim 1.

With regard to the claims of Groups I and III, the Examiner takes the position that they are related as a process of making and product made. MPEP § 806.05(f) sets forth the criteria for determining when a process of making and product made by the process are distinct inventions. A process of making and a product made are distinct inventions if either or both of the following can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process." (Emphasis in original) The

Examiner takes the position that “[i]n the instant case the process to make the product or motor can be made by another in a materially different process.” Applicants assume the Examiner meant to say that the motor claimed in claim 1 can be made by another and materially different process than that claimed in the claims of Group III.

Putting aside the merits of the Examiner’s position, applicants submit that economy is served by not restricting the claims of Group III from the claims of Group I. Comparing claim 1 to claim 24, the first claims of each group, by way of example, applicants submit that the search for claim 24 will involve the same classes as the search for claim 1.

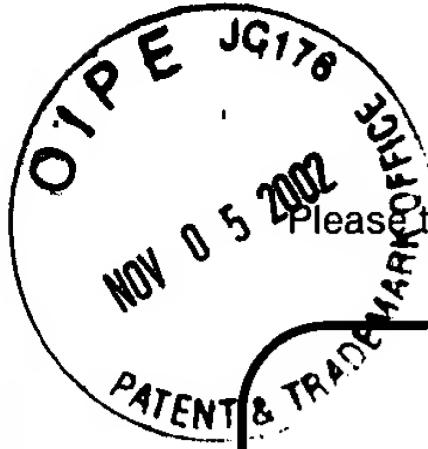
In conclusion, applicants respectfully request that the restriction requirement be withdrawn for the reasons discussed.

Respectfully submitted,

Dated: Nov. 1, 2002

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

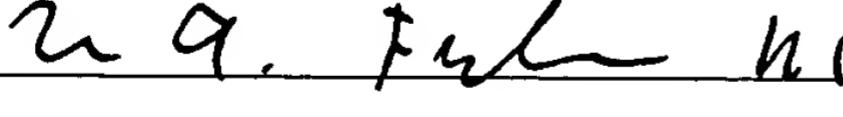
		Application Number	09/755,330
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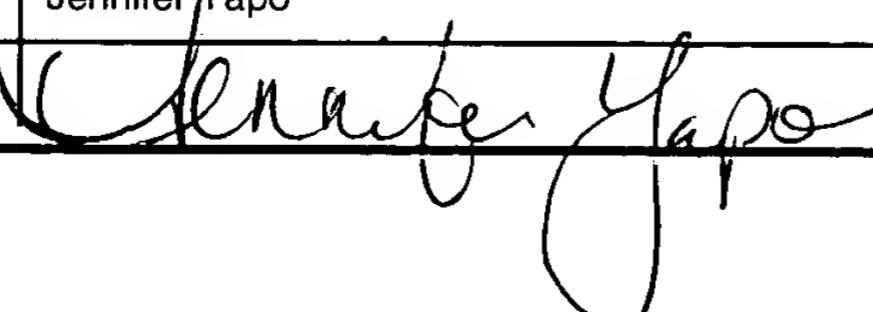
ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
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<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): return receipt postcard
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks

The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2548. A duplicate copy of this sheet is enclosed.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name Roland A. Fuller III	Reg. No. 31,160
Signature			
Date	11/1/02		

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.			
Typed or printed name	Jennifer Yapo		
Signature		Date	11/1/02